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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/978,144 | 10/15/2001 | Scott A. Rosenberg | 03-380 | 4095 |
| 20306 7590 07/17/2007 MCDONNELL BOEHNNEN HULBERT & BERGHOFF LLP 300 S. WACKER DRIVE 32ND FLOOR CHICAGO, IL 60606 | | | EXAMINER CARLSON, JEFFREY D | |
| | | | ART UNIT 3622 | PAPER NUMBER |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|---------------------------------------|---|--|
| Office Action Summary | Application No. 09/978,144 | Applicant(s) ROSENBERG ET AL. | |
| | Examiner Jeffrey D. Carlson | Art Unit 3622 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) 32,33,40,41,46,47,53 and 54 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31,34-39,42-45 and 48-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>See Continuation Sheet</u> . | 6) <input type="checkbox"/> Other: _____ |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :12/11/01, 8/13/02, 3/2/07, 3/2/07, 4/5/07.

DETAILED ACTION

Double Patenting

1. Applicant is advised that should claim 5 (or 8) be found allowable, claim 6 (or 16) will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Objections

2. Claims 39, 43, 45, 48-52 are objected to because of the following informalities:

- Claim 39 should depend from claim 38.
- Claim 43 should depend from claim 42.
- Claims 45, 48 should depend from claim 44.
- Claims 49, 51, the preambles should be amended to include "capable of being executed by a computer processor" to make it clear that the medium stores computer-executable instructions."
- Claim 50 should depend from claim 49.
- Claim 52 should depend from claim 51.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 14, 19, 25, 26, 30, 31, 34, 36, 37, 39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claims 14, 25, 26, there is no antecedent basis for the rules.
- Claim 19, it is unclear what step is actually being performed? A step of designating the predetermined location?
- Claim 30, there is no antecedent basis for an ads placement value.
- Claim 31, 39, 52, it is unclear if applicant is positively requiring entering a pause mode.
- Claim 34 it is not understood what applicant is claiming. While modification of the heap is clear from the specification, it is not clear what “permits the ad to modify”. The ad itself performs a modification? And the “permits...to modify” is unclear as it does not appear that the claim requires any positive step of modifying.
- Claims 36, 37 present system/apparatus claims, yet they include method steps such as providing, that receives, determines, provides, etc. Applicant should include programmed capabilities (i.e. structure) rather than actual performance of steps.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. **Claims 1-25, 27-30, 34-38, 42-45 and 48-51 are rejected under 35**

U.S.C. 102(e) as being anticipated by Eldering (US20020083439).

Regarding claims 1-3, 8, 16, 29, 30, 35, 38, 42-45, 48-51, Eldering teaches personal video recorders (PVRs) that include local hard drive storage for ads [0013, 0014]. The local device includes an ad processing unit which determines the ad queue/order and inserts the ads into available ad opportunities (avails) upon request for an ad [0015, 0046]. More importantly, the ad processing unit also re-orders the ad queue upon certain parameters such as a channel change (i.e. a context change) by the viewer [0016]. This enables the newly re-ordered queue to best target the viewer [0018]. The channel change can be taken to represent a global context parameter.

Regarding claims 4, 36, 37, the re-ordering of the ads of Eldering does not necessarily occur with a new batch of ads and therefore is taken to be asynchronous. Eldering teaches that ads and their metadata (rules) may come from the head-end over a dedicated channel, independent of the programming content [0074]. The metadata is

taken to provide rulesets [fig 6]. Eldering's head end (server) provides programming content as well as the advertising content and metadata.

Regarding claims 5, 6, 11, 13, 15, 34, Eldering teaches that the ad queue is a stacked list of ARLs (ad resource locators) that point to the stored locations for each ad in the queue. The next ad to be played is placed on the top of the heap/stack. [fig 3, fig 6, 0032, 0049]. The ad is removed from the top of the queue once it has been inserted which is also taken to read on claim 34.

Regarding claims 7, the automated re-ordering of the ads triggered by a channel change is taken to represent interpreted rules that are programmed in to the ad selection software.

Regarding claims 9, 10, 14, Eldering teaches that each ad can include various targeting parameters such as time of day, program being watched, identified viewer, etc [fig 5, fig 6, 0081]. The re-ordering of the ad queue according to matched parameters is taken to represent re-ordering a placement value according to a weight value for the ads and their parameters. The ads on the top of the new queue are taken to have higher weighted ad placement values.

Regarding claim 12, Eldering shuffles the ad queue in real-time in advance of the ad insertion requests and therefore accomplishes these tasks asynchronously.

Regarding claims 17-19, the ads of Eldering may be inserted into predefined commercial breaks as conventional full page ads. However, Eldering also teaches that ads may be presented in association with electronic program guides (EPGs); these ads are taken to represent banner ads in predetermined locations on screen [0027].

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Regarding claims 20-22, 24, 25, any of the metadata can be taken to represent the broadly stated placement rule, local parameter value, weight rule and trigger rule.

Regarding claim 23, the FORD ad of figure 6 is taken to have an expiration rule of 9pm.

Regarding claims 27, 28, the PVR inherently includes a clock which is taken to perform the step of updating a global time parameter at predetermined intervals. Further, the ad queue is taken to be re-ordered as needed so as to remove ads whose metadata specify only certain valid insertion times [0050].

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. **Claims 31, 39, 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eldering in view of Armstrong et al (US7017173).**

Regarding claims 31, 39, 52, Eldering teaches ad opportunities peculiar to PVRs such as prepended ads, live shows, recorded shows, end of program ads, etc. Eldering does not appear however to teach inserting an ad upon the detection of a pause mode of the PVR. Armstrong et al however teaches that an interactive video on demand system can insert a targeted ad upon detection of paused programming content [abstract]. It would have been obvious to one of ordinary skill at the time of the invention to have inserted an ad when a user of the system of Eldering enters a pause mode so as to enable additional advertising opportunities for advertisers.

10. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eldering in view of Wong et al (2005/0267994).


Regarding claim 26, Eldering does not teach use of the XML data format. Wong et al teaches a DVR [0198] that receives tokens in the form of XML schema that defines the parameters of advertising to be inserted for display on the DVR [0202]. It would have been obvious to one of ordinary skill at the time of the invention to have used this popular and well known standardized XML format to represent the structure of Eldering's advertising metadata insertion rules.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Mon-Fri 8a-5:30p, (work from home on Thursdays).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Jeffrey D. Carlson
Primary Examiner
Art Unit 3622

jdc